

DOCKET NO.: CEPH-2313 (CP188-C)
Application No.: 10/685,923
Office Action Dated: April 13, 2005

PATENT
REPLY FILED UNDER EXPEDITED
PROCEDURE PURSUANT TO
37 CFR § 1.116

REMARKS

Claims 27-35, 37-40, 42, and 44 are pending in this application. Claims 39, 40, 42, and 44 are allowed. Applicants are herein cancelling claims 27-35, 37-40, 42, and 44, without prejudice or disclaimer, and adding new claims 45-54 to replace the cancelled claims. Applicants would like to thank Examiner Desai for the telephone discussion of June 8, 2005 with Dr. Scott Larsen, and the opportunity to understand the Examiner's position on the non-rejoinder of claims 27-35, 37, and 38 with allowed claims 39, 40, 42, and 44. Applicants offer the enclosed comments and amendments in response to the outstanding Office Action and the discussion.

Amendments to Claims

Applicants are herein cancelling claims 27-35, 37-40, 42, and 44, without prejudice or disclaimer, and adding new claims 45-54 to replace cancelled claims 27-35, 37-40, 42, and 44. Applicants herein present new claims 45-54 applicants as a patentable genus of the present elected invention in order to more fully claim what applicants regard as their invention. New claims 45-54 represent amended forms of claims 27-35, 37-40, 42, and 44, now cancelled, and as such do not present new matter. Support for new claim 45 may be found in cancelled claim 27. New claim 45 has been also been redrafted to more clearly present the order of the substituent groups. Support for new claims 46-49 may be found in cancelled claims 30, 33, 35, and 38. Support for new claims 50 and 51 may be found in cancelled claims 39 and 40. New claims 50 and 51 have been redrafted to more clearly present the chemical bonding of the substituent groups. Support for new claims 52-54 may be found in cancelled claims 43 and 44.

Applicants submit that the amendments to the claims do not introduce new matter and are fully supported by the specification and claims, as originally filed. Applicants request the entry of the amendment under 37 C.F.R. § 1.116(b) because the amendments to the claims

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either cancel claims, comply with requirements of form expressly set forth in a previous Office Action, or present the rejected claims in better form for consideration on appeal.

Election/Restriction and Rejoinder of Non-elected Subject Matter

The Office Action maintains that claims 27-35, 37-38 and 41 are withdrawn as drawn to non-elected subject matter. The Office Action also maintains that claims 27-35, 37 and 38 cannot be rejoined for unidentified scope and reasons under 35 U.S.C. § 112. Applicants strongly traverse the Office's position for the following reasons and request reconsideration in light of the present amendments.

With respect to the Restriction Requirement dated April 27, 2004, applicants submitted a Response on May 27, 2004 stating that "Claims 1, 2, 4-10, 12-14, 20, 21, 25, and 26" were readable thereon. In applicants' Supplemental Response of June 8, 2004, applicants stated that "[n]ew claims 27-43 represent amended forms of claims 1 to 12, 14, 15, 20, 21, 25, and 26". Thus, logically, new claims 27-43 were readable thereon of the election. By the present amendment and response, claims 27-35, 37-40, 42, and 44 are replaced with new claims 45-54; and, thus logically, new claims 45-54 are readable thereon. Applicants, therefore, maintain that the Office's position on withdrawal of non-elected subject matter is in error. Applicants respectfully request reconsideration of the withdrawal of non-elected subject matter.

Applicants further assert the Office's withdrawal of claims 27-35, 37 and 38 (and now claims 45-51) was improper because the Office's response is contrary to MPEP § 821. MPEP § 821 states that "the Examiner should clearly set forth in the Office Action the reasons why the claims withdrawn from consideration are not readable on the elected subject matter." Applicants find *no reasoning* in the Office Action of August 4, 2004 or the present Office Action, why claims 27-35, 37 and 38 are not readable on the elected subject matter. Applicants have clearly identified them as readable thereon. Applicants, therefore, respectfully request reconsideration of the withdrawal of non-elected subject matter.

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Lastly, applicants further assert the Office has not met its burden under MPEP § 803.02 (Restriction Practice re Markush-type Claims). Under MPEP § 803.02 the Examiner must examine all the members of the Markush group in the claim on the merits. If the Examiner finds no prior art that anticipates or render obvious the elected species, the search of the Markush-type claim will be extended. Applicants, in complying with the Restriction Requirement dated April 27, 2004, elected Group X, and identified Example 100 as a species within Group X. Applicants submit that said election is in compliance with MPEP § 809.02(a), which requires the Examiner, when generic claims are present, to (A) identify generic claims, (B) group the claims in accordance with the species (even if they cannot be conveniently identified) to which they are restricted, and (C) *require the Applicant to elect a single disclosed species* (emphasis added). Under MPEP § 809.02(a), applicants response of May 27, 2004, including the election of species and identifying all claims readable thereon was complete, thus requiring the Office to examine the merits of the claims under MPEP § 803.02. Accordingly, applicants submit that withdrawal of the "non-elected subject matter" and/or non-rejoinder is still improper because the Office has not cited any prior art that anticipates or render obvious the elected species; thus requiring the search of the generic claims to be extended.

Conclusions

In view of the foregoing, applicants believe that the new claims are in allowable form. In the event that the Examiner finds any remaining impediment to the prompt allowance of this application, which could be clarified by a telephonic interview, or which is susceptible to being overcome by means of an Examiner's Amendment, the Examiner is respectfully requested to initiate the same with the undersigned attorney.

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Wendy A. Choi
Registration No. 36,697

WOODCOCK WASHBURN LLP
One Liberty Place - 46th Floor
Philadelphia PA 19103
Telephone: (215) 568-3100
Facsimile: (215) 568-3439